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REMARKS

In an office Action dated 29 June 2007, the Examiner rejects claims 1, 5-7, 11-13, 17-21, and 25-30 (all pending claims). In response to the Office Action, Applicants traverse the rejections. Claims 1, 5-7, 11-13, 17-21, and 25-30 remain pending in the application. In light of the following arguments, Applicants respectfully request that this application be allowed.

I. Claims 1, 7, 13, 19, 29 and 30 are rejected under 35 USC 103(a) as being unparentable over Claessens et al. (US 7,222,255) in view of Zerlan (US 7,010,295). Claims 1, 7, 13, and 19 are all of the independent claims currently pending in this application. Applicant respectfully traverses the rejection of these claims and asserts that Examiner has failed to make a prima facie case to support a 35 USC 103(a) rejection, as Claessens and Zerlan fail to disclose all of the claimed limitations in independent claims 1, 7, 13, and 19, as well as claims 29 and 30.

A. Specifically, Applicant directs Examiner's attention to the Office Action mailed June 29, 2007, page 3, at the fourth paragraph. Examiner asserts that Claessans discloses means 202 for establishing an IP routing path for a session to be tested (fig. 2, col. 9 lines 61-67 and col. 10 lines 1-10). Applicant asserts that Claessans does NOT disclose means for establishing an IP routing path for a session to be tested. Claessans, at col. 9, lines 61-67 reads:

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FIGS. 4A and 4B are a flow chart illustrating an exemplary method 400 for setting up a network performance test by a control network device according to an exemplary embodiment. Referring to FIG. 4A, at step 402, a device under testing is selected. In one embodiment, a system administrator may select a device under testing via a graphical user interface on the control machine, for example. In another embodiment, a system administrator may select more than one device under testing for a network performance testing. Further, the system administrator selects testing paths in a network test performance testing system. According to an exemplary embodiment, an inventory database associated with the control network device stores a list of network devices in the system. In an exemplary embodiment associated with the method 400, the system administrator selects cable modems or, specifically, MAC addresses of the cable modem, to specify the network testing paths.

Firstly, Claesanns at this portion cited above clearly shows that a device, not a session, is being tested. Applicant's independent claims 1, 7, 13 and 19 are clearly limited to testing a network session.

Secondly, Claesenns discloses a human being performing steps that Examiner is likening to claim limitations of the present invention. OUTSIDE AND APART from Claessens' network control device 202, a human, system administrator selects testing paths. Furthermore, these paths are based on the administrator selecting the MAC addresses of the cable modems involved in the test. As claim 7 clearly claims the limitation of a program storage device containing a computer program that selects the

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paths, a system administrator certainly cannot be construed as the equivalent of computer instructions, nor apparatus (as claimed in claim 13), nor system (as claimed in claim 19).

B. Applicant further asserts that Claessens also fails to disclose, teach, or otherwise suggest the claimed limitation of sending a constant stream of packets to a second end. Examiner cited Claessens at col. 5 lines 19-27, which reads:

The exemplary network performance testing system 200 is based on four main components: a control network device 202, packet generators 212, 218, 224, 232, packet receivers 214, 216, 228, 230, and network switches 204, 206, 208, 210, 226, 234, 236 interconnecting all components of the system. According to an exemplary embodiment, the packet generators 212, 218, 224, 232 generate and send packets based on the instructions from the control network device 202.

Applicant cannot find any mention of a continuous stream of packets in the above-cited portion of Claessens. All that is being described here is the major components of testing system 200, but there is no indication as to how the packets are streamed to the packet receivers.

Applicant submits that since at least two of the claimed limitations appearing in all of the independent claims 1, 7, 13 and 19 are not shown in Claessens, Examiner has

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failed to produce a combination of references that include all the claimed limitations in sufficient detail as claimed.

II. Applicant also respectfully submits that Claessens and Zerlan cannot be combined to arrive at Applicant's claimed invention. Claessens operates over a cabled network. Claessens introduces the problem to be solved in the context of FIG. 1's data-over-cable architecture 100 (col. 3, lines 28-29) of computers, and makes no attempt to distinguish the system 200 in FIG. 2 from such a cabled architecture. Likewise, FIG. 2 in Claessens is organized in a similar manner as Claessens's admitted prior art FIG. 1. Furthermore, Claessens describes the use of a connectionless protocol (UDP). Zerlan, on the other hand, is an automatic system of testing network elements in a wireless telephony architecture. There are no system administrators to select network paths, as the architectures involved are completely different and vastly different in size.

Thus, as Zerlan does not suggest combining with Claessens and Claessens does not suggest combining with Zerlan, Applicant submits that Examiner employed impermissible hindsight to arrive at the combination of Claessens and Zerlan.

Despite Examiner clearly stating in the Office Action mailed June 29, 2007, that the motivation to combine Claessens and Zerlan lies in reduced cost and offers more enhanced security than dynamic route, Applicant traverses this assertion as sufficient motivation to combine. Applicant respectfully asserts that such a statement is merely Examiner's assertion, and respectfully request that Examiner provide some evidence,

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either in the references themselves, or at least in some other references, to show that a motivation to combine existed.

Applicant is aware that many unsaid benefits can come to an Examiner's mind once Examiner has seen Applicant's invention, but such ability unchecked simply allows to list a feature of the invention not discussed in the description, either upon reading the detailed description portion or viewing the figures, and issue a 35 USC 103 rejection, but Examiner is reminded of *In re Linter*, which states that "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to sufficient for one of ordinary skill in the relevant art having a reference before him to make the proposed substitution, combination, or other modification." *In re Linter* 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Applicant requests Examiner to provide proof of Examiner's assertion that the use of a static IP channel would cost less to implement than dynamic channel.

If Examiner bases the combination on *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Circ. 1986), Applicant submits that the facts of *Merck* are not present in either *Claessens* and *Zerlan*, as in *Merck*, the prior art suggested that compounds similar to those claimed in *Merck* would be expected to have similar activity because the structural difference between the compounds involves a known replacement and a research paper compared the properties of the compounds at issue. Applicant submits that if Examiner knows of any support highlighting the contemplation of combination of references, as was present in *Merck*, to the present references, Applicant requests

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Examiner submit such evidence, otherwise the rejection of claims 1, 7, 13, and 19, and therefore claims 2-6 depending from claim 1, claims 8-12 depending from claim 7, claims 16-18 depending from claim 13, and claims 20-30 depending from claim 19

For the above reasons, Applicants respectfully request the rejection of claim 1 be removed and claim 1 be allowed.

Claims 5-6 are dependent upon amended claim 1. Thus, claims 5-6 are allowable for the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 5-6 be removed and claims 5-6 be allowed.

Claim 7 recites a program storage device that stores instructions for providing the method of amended claim 1. Thus, amended claim 7 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 7 be removed and amended claim 7 be allowed.

Claims 11-12 are dependent upon amended claim 7. Thus, claims 11-12 are allowable for the same reasons as amended claim 7. Therefore, Applicants respectfully request that the rejections of claims 11-12 be removed and claims 11-12 be allowed.

Amended claim 13 recites an apparatus for performing the method of amended claim 1. Thus, amended claim 13 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejection of claim 13 be removed and amended claim 13 be allowed.

Claims 17-18 are dependent upon amended claim 13. Thus, claims are allowable for the same reasons as amended claim 13. Therefore, Applicants respectfully request that the rejections of claims 17-18 be removed and claims 17-18 be allowed.

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Amended claim 19 recites a system that provides the method of amended claim 1.

Thus, amended claim 19 is allowable for at least the same reasons as amended claim 1.

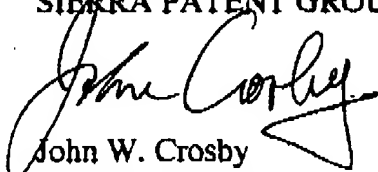
Therefore, Applicants respectfully request that the rejection of claim 19 be removed and amended claim 19 be allowed.

Claims 20-21 and 25-30 are dependent upon amended claim 19. Thus, claims 20-21 and 25-30 are allowable for the same reasons as amended claim 19. Therefore, Applicants respectfully request that the rejections of claims 20-21 and 25-30 be removed and claims 20-21 and 25-30 be allowed.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
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Dated: September 30, 2007


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